

REMARKS

For the convenience of the Examiner set forth below is a recapitulation of the current status of the claims in the present Application:

CLAIM	STATUS	DEPENDENCY
1.	Cancelled	—
2.	Cancelled	—
3.	Cancelled	—
4.	Cancelled	—
5.	Cancelled	—
6.	Cancelled	—
7.	Cancelled	—
8.	Cancelled	—
9.	Cancelled	—
10.	Currently amended	13
11.	Currently amended	13
12.	Currently amended	10
13.	New	Independent
14.	New	13
15.	New	13
16.	New	15
17.	New	15

Comments of Primary Examiner Bryan R. MULLER have been reviewed carefully along with pertinent sections of the Patent Act, Patent Rules, the Manual of Patent Examining Procedure, legal treatise and relevant decisional law. Allowances of the Application, as amended, are solicited earnestly.

A Request for Continued Examination (RCE) Transmittal and a check in the amount of \$395.00 to cover the RCE fee are enclosed.

A Terminal Disclaimer to Obviate a Double Patenting Rejection Over a "Prior Patent" dated March 29, 2005 was filed along with a check in the amount of \$65.00 was filed with a previous Amendment dated March 29, 2005.

A copy of the previously filed Terminal Disclaimer is enclosed for the convenience of the Examiner.

A new Terminal Disclaimer to Obviate a Double Patenting Rejection Over a "Prior Patent" is enclosed herewith to overcome a double patenting rejection which is based on US Patent No. 6,857,339 and copending Application No. 10/854,344, a check in the amount of \$65.00 is enclosed.

The subject matter for Claim 5 has been rewritten to overcome the rejection under 35 USC 112 and has been presented as new Claim 13. No new matter has been added. Claim 13 is believed to be patentable. Claim 5 has been cancelled.

Claims 10 and 11 have been amended to depend from new Claim 13. New Claims 14-15 depend from Claim 13 and are believed to be patentable in view of this dependency. New Claims 16 and 17 depend from Claim 15 and are believed to be patentable in view of this dependency.

Claim 12 has been amended to overcome the rejection under 35 USC 112. The term "O-ring" has been cancelled. No new matter has been added.

The Specification and Abstract have been amended to correct English usage. No new matter has been amended.

Claims 5 and 11 have been rejected under 35 USC 103 a as being unpatentable over the (2002/0023519) in view of Over et al. (3,436,992) or Chen (6,516,930).

Claims 10 and 12 have been rejected as being unpatentable over the (2002/0023519) in view of Over et al. (3,436,992) or Chen (6,516,930) and further in view of Chang (6,382,051).

Reconsideration of the Examiners rejection of Claims 5, 10, 11 and 12 is requested on the following basis. Examineration of the Hu, Over et al., Chen and Chang patents reveals the following differences between the structures shown thereon, the structure of the present invention and the statements of the Examiner.

1. The Examiner is correct in stating that Hu fails to disclose a direction controller pawls including a toothed face.

2. The Examiner states that both Chen and Over et al. suggest that use of two spring biased pawls.

3. Chen shows a pair of pawls and a ring however in Chen the ring has two sets of bevel teeth and each pawl has two sets of bevel teeth. The present invention does not use two sets of bevel teeth an each member. In addition, Chen does not show an operating mechanism for operating the pawls and Hu does not show a mechanism for operating two pawls or any pawls. The teaching of Hu and Chen does not lead to the present invention.

4. Over et al. does not show a direction switch defining a recess as shown in the present Application and as claimed in new Claim 13.

5. Chang shows a single pawl and does not show a direction switch of any kind. The structure of Chang thus does not lead to the structure of the present invention.

There is no teaching in the Hu, Over, et al., Chen or Chang references alone or in combination which leads to the structure of the present invention.

For the above reasons the application of the Hu, Over, et al., Chen or Chang references is not considered to be appropriate.

In a famous footnote in *Hodosh v. Block Drug Co.*, 786 F2d 1136, 229 USPQ 182, 1897 (Fed. Cir., 1986), the Federal Circuit set out five principles, with citations to previous cases, regarding obviousness determinations under Section 103. The footnote (as to the first four principles reads as follows:

Our comments on the district court's obviousness determination generally include the following tents of patent law that must be adhered to when applying § 103;

(1) the claimed invention must be considered as a whole (35 USC 103); see, e.g. *Jones v. Harty*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir., 1984) (though the differences between claimed invention and prior art may seem slight, it may also have been taken the key to advancement of the art);

(2) the references must be considered as whole and suggest the desirability and thus the obviousness of making the combination (see, e.g., *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 220 USPQ 481, 488 (Fed. Cir. 1984);

(3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention (e.g. *W.I. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983));

(4) “ought to be tired” is not the standard with which obviousness is determined (*Jones, supra*, 727 F.2d at 1530, 220 USPQ at 1026.

The fifth tenet or principle deals with the presumption of validity and is not germane to the issues hereininvolved.

It is submitted that the Examiner’s position in applying Hu, Over, et al., Chen and Chang is contrary to the above-quoted tents of the Court of Appeals for the Federal Circuit, particularly the first three. When the claimed invention is considered fairly as whole, it is self-evident that Applicant’s invention is not rendered obvious by the cited prior art, whether considered alone or in combination.

The statutory presumption of 35 USC § 282 makes an invention presumptively non-obvious unless the Examiner can demonstrate the “the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skills in the art to which said subject matter pertains,” 35 USC § 103.

Obviousness is a legal conclusion based on four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention; (3) the level of the ordinary skill when the invention was made; and (4) any other objective considerations including evidence of commercial success, copying, and a long-felt need in the industry. *Continental Can Co. v. Monsanto Co.*, 948 F2d 1264, 1270, 1273 (Fed. Cir. 1991)

(citing *Graham v. Deere Co.*, 383 US 1.17 (1966)). The decision maker is not to apply hindsight, but must analyze obviousness from the viewpoint of a person skilled in the art prior to the disclosure of the present invention *Panduit Corp. v. Dennis Mfg. Co.*, 810 F2d 1561, 1566 (Fed. Cir.), *cert denied*, 481 US 1052 (1987).

Objective evidence of non-obviousness (long-felt need, commercial success, copying must always be taken into account; it is not merely “icing on the cake.” *Hybrietch, Inc. v. Monoclonal Antibodies, Inc.*, 802 F2d 12367, 1380 (Fed. Cir. 1986), *cert. denied*, 4580 US 947 (1987). The Federal Circuit has stated that:

(I)n~~deed~~, evidence of secondary considerations may often be the most probative and cogent evidence in the record it may often establish that an invention appearing to have been obvious in light of the prior art was not.

The Examiner has attempted to reconstruct Applicant’s invention from selecting bits and pieces from Hu, Over, et al., Chen or Chang. The cherry picking exercise is just the sort of hindsight reconstruction which the Federal Circuit has warned against repeatedly. Nothing in the prior art suggests to a person of ordinary skill in the art to combine those elements in the way Applicant did to arrive at his invention. *Panduit Corp.* 810 F2d at 1568. The prior art existed for many years and yet those skilled in the art never created ratchet wrench comparable to Applicant’s. See *id.* at 1577 (that skilled workers did not create (patented) invention, despite existence of elements in the prior art, is evidence of non-obviousness).

The objective evidence, such as whether the invention solves a long-standing problem, weigh strongly in favor of conclusion that Applicant’s invention is not obvious. *Continental Can*, 948 F2d at 1273.

The status of the Claims is as follows:

Claims 1-9 have been cancelled.

Claims 10-12 have been amended.

Claims 13-17 are new.

In view of the foregoing submissions and explanations, it is believed that Claims 10-17 as amended, are in condition for allowance. An early Notice of Allowance on the Application will be appreciated.

The commissioner is authorized to credit any overpayments or debit any deficiency to Deposit Account 02-1435.

Courtesy, cooperation and skill of Examiner Bryan R. MULLER are appreciated and acknowledged.

Date: New York, New York
December 16, 2005

Respectfully,

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CEB:rmm/15393 B

Enclosure: New Terminal Disclaimer;

Previously filed Terminal Disclaimer;

Request for Continued Examination;

Check in the amount of \$460.00 for Terminal Disclaimer (\$65.00) and RCE (\$395.00).